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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,433	02/13/2004	Esther C. Fuhrman	103342-48580	8761
26345	7590	04/29/2005	EXAMINER	
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE 1 RIVERFRONT PLAZA NEWARK, NJ 07102-5497			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,433

Applicant(s)

FUHRMAN ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

- [1] Claims 1-17 are pending.

Drawings

- [2] The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the free end of the safety catch that passes through the slot to extend outwardly beyond the depth of the slot in the second housing (concerns claims 9, 17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

[3] The disclosure is objected to because of the following informalities:

Minor formatting issue. On page 7, line 15, "housing 12," should be: "housing 14."

Appropriate correction is required.

Claim Objections

[4] Claim 1 is objected to because of the following informalities: the use of the term magnetic as stated in line 2 is incorrect. Consider changing to magnet.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller, US-1,807,293, in view of Levy, US-5,008,984.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Keller teaches of a jewelry fastener comprising a first housing (1), a second housing (11) having first (17) and second (11) external surfaces; a safety catch (6) having one end pivotally mounted to the first housing (5) and having a protuberance extending outwardly from the other end (7), said second housing (11) having a slot (8) formed therein that passes fully through the second housing (11) to be accessible through both said first (8) and said second external surfaces (8'), said safety catch (6) being rotatable about the pivotal mounting (5) to a locked position wherein the protuberance

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(7) enters the slot (8) through either the first (8) or second external (8') surfaces of the second housing (11) to retain the first (1) and second (11) housings together (Fig. 2).

However, Keller fails to disclose expressly that each of the housing members contain a permanent magnet having a facing surface.

Levy teaches of a magnetic jewelry closure with clip that teaches of a first (28 of Levy) and second (4 of Levy) housing containing permanent magnets (8,6 of Levy) each having a facing surface, said permanent magnets (8,6 of Levy) both being magnetized so that the line of greatest magnetic force is perpendicular to the facing surfaces (Fig. 2 of Levy), said facing surfaces of the permanent magnets attracted to each other when positioned proximate to each other and within the field of the magnetic forces (Fig. 2 of Levy).

[Examiners note from lines 7-8]: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the jewelry fastener as taught by Keller, to incorporate magnets in each of its respective housing entities as taught by Levy, in order to provide additional securement to the clasp as well as to help the components of the clasp be brought together by in a more accurate, specific orientation, whereby the catch can then be properly inserted into the structure of the device. That is, as stated by Levy, in column 2 line 13, "The members join by magnetic attraction and the clip is closed to secure the closure". Continuing, "Due to the magnetic attraction between the members of the closure, the members seek each other and even if the user is infirm or disabled, the jewelry may be

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closed effortlessly. After joining the closure members together, the clip is closed and the closure members cannot be separated until the clip is released.” In other words, the magnets aid in the combining the two houses or members of the closure, thereby allowing the clip or safety catch to secure the closure.

Re: Claim 2, wherein the first housing (1) has an opening and the permanent magnet in the second housing fits into the opening in the first housing to place the permanent magnets in close proximity to each other to magnetically attract each other (Keller in view of Levy, utilizing the teaching of magnets from Levy into that of the first and second housings of Keller to allow attraction between the two houses).

Re: Claim 3, wherein the safety catch has a straight member pivotally mounted to the first housing and the protuberance extends from the free end thereof at an angle of about 90 degrees (7 of Keller).

Re: Claim 4, wherein the slot has an outer surface having at least one indentation and said protuberance has at least one protruding nib that snaps into the at least one indentation when said safety catch is in said locked position to hold the first and second housings together (8 in Fig. 2 of Keller).

Re: Claim 5, wherein said at least one indentation is one indentation that is located about equidistant between each of the first and second external surfaces of the second housing (8 in Fig. 3 of Keller).

“About” is not indefinite in as much as its meaning is not broad and arbitrary; rather, term is clear and flexible and “approximately” or “nearly.” *Ex parte Eastwood Brindle & Knob* (PO BdApp) 163 USPQ 316.

Re: Claim 6, wherein the indentation is formed in a spring steel material (Note that it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material, therefore, in this case, it would have been readily apparent to one skilled in the art to use a spring steel material for the indentation so that the effect of snapping may be enhanced).

Re: Claim 7, wherein the safety catch has a magnetically attractable material or magnet that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, "...fastener which will be simple, strong and durable construction..." Thus, due to such; steel is indeed a material that can be considered a "magnetically attractable material").

Re: Claim 8, wherein the magnetically attractable material comprises a magnet or steel plate affixed along an internal surface of said safety catch (see above).

Re: Claim 9, wherein said protuberance has a free end that passes through and extends outwardly beyond the depth of the slot in the second housing when the safety catch is in said locked position (7 through 8 of Keller in Fig. 2).

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As for Claim 10, Keller in view of Levy teach of a method of completing the connection of a jewelry clasp comprising the steps of:

providing a first housing having a jewelry chain affixed thereto (12 in Keller), a pair of oppositely disposed external surfaces and having magnetic surface (Keller in view of Levy),

providing a second housing having a jewelry chain affixed thereto and having a magnetic surface (2 in Keller);

joining the first (1) and second (11) housings together by aligning and facing the magnetic surfaces facing each other (Keller in view of Levy);

providing a safety catch (6) movable affixed to the second housing and adapted to be movable to a locked position (Fig. 2);

providing a slot (8, 8' in Fig. 2) in the first housing that extends entirely through the housing and opening through both of said oppositely disposed external surfaces (8, 8' in Fig. 2);

engaging the first (1) and second (11) housings together to align the magnetic surface of the first housing with the magnetic surface of the second housing abutted together to complete the connection of the first and second housings together (Keller in view of Levy); and

moving the safety catch to the locked position wherein the safety catch enters into the slot through the opening in either of the oppositely disposed external surfaces (7 into 8, 8' Fig. 2).

Re: Claim 11, wherein the step of providing a first housing and the step of providing a second housing comprises providing a first housing and a second housing

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having permanent magnets disposed therein forming the magnetic surfaces (Keller in view of utilizing the teaching of magnets from Levy).

Re: Claim 12, wherein the step of providing a safety catch comprises providing a safety catch (6) having a nib extending outwardly therefrom (8 in Fig. 2) and said step of providing a slot comprises providing a slot (8 in Fig. 2) having an indentation formed therein and said step of moving the safety catch to a locked position comprises engaging the nib within the indentation (7 into 8 in Fig. 2 of Keller).

Re: Claim 13, wherein the step of providing a safety catch comprises providing a safety catch having a magnet or magnetically attractable material that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, "...fastener which will be simple, strong and durable construction..." Thus, due to such; steel is indeed a material that can be considered a "magnetically attractable material").

Re: Claim 14, wherein the step of providing a safety catch comprises providing a safety catch (6) having a nib extending outwardly therefrom (8 in Fig. 2) and said step of moving the safety catch to a locked position comprises moving the safety catch to a position where the magnetically attractable material is attracted to the permanent magnet in said second housing (Keller in view of Levy, also; see Claim 13 rejection).

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Re: Claim 15, wherein the step of providing a safety catch comprises providing a safety catch (6) having a magnetically attractable material (Claim 13) located on a surface that overlies one of the oppositely disposed external surfaces of the second housing (15 and above in Fig. 2).

Re: Claim 16, wherein the step of providing a safety catch comprises providing a safety catch (6) having the magnet or magnetically attractable material (Claim 13) located on a surface that abuts against an internal surface of the slot formed in the second housing (7 into 8 in Fig. 2).

Re: Claim 17, wherein the step of moving the catch to the locked position comprises moving the safety catch to a position where the safety catch has a free (end of 7) end that passes through the slot (8) to extend outwardly therefrom and said method further comprises the step of moving the safety catch from its locked position (7 in 8 in Fig. 2) by pushing on the free end of the safety catch extending from the slot (one could push from the bottom of 7 in Fig. 2 upwards to release the catch from the slot).

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Conclusion

[7] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The following patents are cited further to show the state of the art with respect to this particular type of clasp; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER